REMARKS/ARGUMENTS

Claims 1-120 are pending in the present application.

This Amendment is in response to the Office Action mailed March 18, 2005. In the Office Action, the Examiner rejected claims 1-120 under 35 U.S.C. §103(a). Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

1. In the Office Action, the Examiner rejected claims 1-4, 7-14, 17-22, 24-36, 38-52 and 54-120 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,124,806 issued to Cunningham et al. ("Cunningham") in view of U.S. Patent No. 5,835,907 issued to Newman ("Newman") and claims 5-6, 15-16, 23, 37 and 53 under 35 U.S.C. §103(a) as being unpatentable over Cunningham in view of Newman and further in view of U.S. Patent No. 5,544,225 issued to Kennedy, III et al. ("Kennedy"). Applicant respectfully traverses the rejection and contends that the Examiner has not met the burden of establishing a prima facie case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004).* Applicants respectfully contend that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Applicant reiterates the arguments set forth in the previously filed Response to the Office Action.

a) Claims 1-4, 7-14, 17-22, 24-36, 38-52 and 54-120:

In the Office Action, the Examiner rejected claims 1-4, 7-14, 17-22, 24-36, 38-52 and 54-120 under 35 U.S.C. §103(a) as being unpatentable over Cunningham in view of Newman. Applicant respectfully disagrees.

Cunningham discloses a wide area remote telemetry to obtain information on consumer utility usage. A sensor interface module sends the customer demand and usage information to data collection modules over unlicensed radio frequency bands (Cunningham, col. 4, lines 54-58). The data collection modules transmit the information over a data module connection to a network system (Cunningham, col. 4, lines 58-62). The network system forwards the information to a host module here the information is stored and processed (Cunningham, col. 7, lines 19-27).

Newman discloses an emergency personal communication services (PCS) system for identification and notification of a subscriber's location. An emergency PCS device receives signal transmission from several GPS satellites, converts the received signals information identifying a location of the emergency PCS device, and transmits the location and a code to a network over a wireless medium (Newman, col. 2, lines 21-29). If the emergency distress signal has not been activated, a voice processing system provides on-demand information on the subscriber's location to a telephone caller (Newman, col. 2, lines 43-46). There is no activation message being sent in response to a telephony call.

Cunningham and Newman, taken alone or in any combination, do not disclose, suggest, or render obvious (1) a decoder to decode an activation message, the activation message being sent from an activator in response to a telephony call, the decoder generating an activation command, and a transmitter/receiver to transmit/receive an information message responsive to the activation command, as recited in independent claims 1 and 11, 61, 71, 81, 91, 101, and 111, (2) each transmitter comprising a transmission unit to broadcast a signal modulated from an information message containing respective location information in response to a telephony call, as recited in independent claim 21, (3) receiving a location information request, the location information request requiring a location information, generating at least one data packet comprising the location information; and transmitting the at least one data packet in response to the location information request, as recited in claim 38, (4) a networkable component comprising a receiver/ means for receiving location information in response to a telephony call, a processor/means for processing the location information, and a network interface/interface means for transmitting the location information over a network, as recited in independent claims 54 and 57, (5) a networkable component comprising a location sensor to provide location

information in response to a telephony call, a determination unit coupled to the sensor, the determination unit to determine the location information, and a network interface coupled to the determination unit to selectively transmit the location information over a network, as recited in claim 60.

Specifically, Applicant contends that Cunningham merely discloses the transmission of the usage information from the sensor interface module to the data collection module, then to the host module, and finally to the customer interface. When in the receive mode, the data collection module continuously scan a frequency based searching for a radio frequency signal (Cunningham, col. 20, lines 20-24). In the transmit mode, the data collection module uploads the information to the host module on a periodic time basis, at a preset time, or in response to a demand from the host module (Cunningham, col. 32, lines 29-34). Therefore, Cunningham is teaching away from the invention. First, Cunningham does not disclose or suggest sending an activation message in response to a telephony call. In the Office Action, the Examiner states that the sensor interface module is an activator which transmits the information over unlicensed radio frequency bands (Office Action, page 3, lines 1-3). Applicant respectfully disagrees. The sensor interface module sends the information, not an activation message. Second, Cunningham, does not disclose or suggest transmitting a signal modulated from an information message to a receiver in response to the activation command.

The sensor interface module or the data collection modules disclosed in Cunningham are neither decoder nor activator. The sensor interface module merely sends customer demand and usage information. The data collection modules merely transmit the received demand/usage information to a network. There is no activation message in response to a telephony call.

In the Office Action, the Examiner contends that it is inherent that the data collection module 10 includes a decoder to decode the received information or messages or generating an activation command (Office Action, page 27, lines 10-13). Applicant respectfully disagrees.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 193). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Here, the Examiner did not provide a basis in fact and/or technical reasoning to reasonably support the determination that a decoder necessarily is required in the data collection module. The data collection module merely forwards information received from a multi-path sensor interface module (Cunningham, col. 6, lines 55-65) or transmits the information received from the sensor interface module to a network system (Cunningham, col. 7, lines 19-21). There is no technical basis that the data collection module has to decode the information received from the sensor interface module. Furthermore, there is no technical basis for the information from the sensor interface module to be an activation message.

In addition, the combination of Cunningham and Newman is improper. Newman does not disclose the activation message being sent from an activator in response to a telephony call. Newman merely discloses a voice processing system to provide the information.

In the Office Action, the Examiner states that Newman teaches sending an activation message in response to a telephone call, citing Newman, col. 2, lines 43-49 (Office Action, page 26, item 5). For ease of reference, the cited paragraph is copied below.

> "... after the conversion and storage, emergency services and/or a designated contact are automatically notified if an emergency distress signal has been activated by the subscriber. Alternatively, if the emergency distress signal has not been activated, a voice processing system provides on-demand information on the subscriber's location to a telephone caller who supplies the emergency PCS device's code. The voice processing system interfaces with the telephone caller, as well as the database via the computer network." (Newman, col. 2, lines 40-48.)

As clearly seen from the above, Newman merely discloses that if an emergency distress signal has not been activated, a voice processing system provides on-demand information on the subscriber's location to a telephone caller who supplies the emergency PCS device's code. On-demand information on the subscriber's location is not an activation message. Furthermore, even if the on-demand information is an activation message, Newman does not disclose or suggest a decoder to decode this on-demand information.

Furthermore, Cunningham cannot be modified according to the teachings of Newman because remote telemetry periodically sends information to the host, not sending information to a server in response to a telephone call. Modifying Cunningham would render the technique unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to make the proposed modifications.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01.

In the Office Action, regarding claims 21, 38, 54, and 60, the Examiner contends that Cunningham discloses each transmitter comprising a transmission unit to broadcast a signal modulated from an information message wherein the data collection module transmits the information to the host module over the commercially available information transmission systems, citing Cunningham, col. 4, lines 60-63 (Office Action, pages 11-12; page 18; page 21). Applicant respectfully disagrees. The data collection module merely gathers the information from the sensor interface module which monitors individual customer demand and usage (Cunningham, col. 4, lines 54-56). The sensor interface module is attached to gas, electric, and water meters (Cunningham, col. 7, lines 32-34). Therefore, the information sensed by the sensor interface module is not location information. In addition, as discussed above, Newman does not disclose or suggest broadcasting a signal modulated from an information message containing respective location information in response to a telephony call. The emergency device in Newman periodically receives coordinates from the GPS satellites and sends its location information to the computer via the PCS network (Newman, col. 3, lines 34-36). The device,

therefore, either periodically sends the information, or when an emergency distress button is pressed (Newman, col. 3, lines 41-46), not in response to a telephony call.

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion or motivation to combine the references. "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985).

In the present invention, the cited references do not expressly or implicitly suggest sending an activation message in response to a telephone call and transmitting/receiving an information message responsive to an activation command. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Cunningham, and Newman is an obvious application of such an automatic communication mode.

There is no motivation to combine Cunningham and Newman because neither of them addresses the problem of automatic remote communication. There is no teaching or suggestion that a decoder to decode activation message is present. Cunningham, read as a whole, does not

suggest the desirability of decoding an activation message, sending the activation message in response to a telephone call, generating a command, and transmitting/receiving an information message responsive to the command.

b) Claims 5-6, 15-16, 23, 37 and 53:

In the Office Action, the Examiner rejected claims 5-6, 15-16, 23, 37 and 53 under 35 U.S.C. §103(a) as being unpatentable over Cunningham in view of Newman and further in view of Kennedy. Applicant respectfully disagrees.

Cunningham discloses a wide area remote telemetry to obtain information on consumer utility usage, and Newman discloses an emergency personal communication services (PCS) system for identification and notification of a subscriber's location, as discussed above.

Kennedy discloses data messaging in a cellular communications network. Voice/data links support transmission of data over a voice channel using a modem, dual-tone multifrequency (DTMF) tones (Kennedy, col. 6, lines 1-3).

Cunningham, Newman, and Kennedy, taken alone or in any combination, do not disclose, suggest, or render obvious (1) a decoder to decode an activation message, (2) the activation message being sent from an activator in response to a telephony call, (3) the decoder generating an activation command, (4) a transmitter/receiver to transmit/receive an information message responsive to the activation command, (5) a modulator to modulate the information message according to a modulating as recited in claims 4 and 14, from which claims 5 and 15 depend, (6) the modulating scheme is compatible with a sound signal, as recited in claims 5, 15, (7) a transmission unit to broadcast a signal modulated from an information message containing respective location information in response to a telephony call as recited in claim 21 from which claim 23 depends, (8) the transmission unit broadcasting the respective location information on a substantially continuous basis, as recited in claim 23, (9) an e-commerce transaction processor wherein the location event is generated by the e-commerce transaction processor, as recited in claim 37, and (10) the networkable component comprises an association with a commercial transaction, as recited in claim 53.

There is no motivation to combine Cunningham, Newman, and Kennedy because none of them addresses the problem of automatic remote communication. There is no teaching or

suggestion that a decoder to decode activation message is present. Cunningham, read as a whole, does not suggest the desirability of decoding an activation message, sending the activation message in response to a telephone call, generating a command, and transmitting/receiving an information message responsive to the command.

As discussed above, Cunningham and Newman, either taken alone or in any combination, do not disclose or suggest the elements of the independent claims from which the rejected claims 5-6, 15-16, 23, 37 and 53 depend. Therefore, a combination of Cunningham, Newman, and Kennedy is improper.

Furthermore, Kennedy merely discloses voice/data links support transmission of data over a voice channel using a modem, dual tones multi-frequency tones (Kennedy, col. 6, lines 1-3). Kennedy does not disclose or suggest transmitting a signal modulated from an information message in response to the activation command. The data over a voice channel does not correspond to an information message.

In the Office Action, regarding claim 23, the Examiner contends that Cunningham as modified by Newman and Kennedy teaches the transmission unit broadcasts the respective location information on a substantially continuous basis, citing Newman, col. 1, lines 6-11 and col. 3, lines 19-30 (Office Action, page 25, 4th paragraph). Applicant respectfully disagrees. Newman merely discloses sending the location information to an emergency service at its request (Newman, col. 1, lines 6-10) or automatically to emergency services (Newman, col. 3, lines 24-25), not in response to a telephony call.

Regarding claim 37, the Examiner contends that Cunningham as modified by Newman and Kennedy teaches an e-commerce transaction processor, citing Newman, col. 1, lines 6-11 and col. 3, lines 19-30 (Office Action, page 25, 5th paragraph). Applicant respectfully disagrees. As discussed above, Newman merely discloses sending location information to an emergency service. This does not involve an e-commerce transaction processor.

Regarding claim 53, the Examiner contends that the networkable component comprises an association with a commercial transaction, citing Figure 1 of Kennedy. Applicant respectfully disagrees. Figure 1 of Kennedy merely shows a communication system including cellular systems, clearing house, platforms, and hosts, not an association with a commercial transaction.

Therefore, Applicant believes that independent claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, 111 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection(s) under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: June 9, 2005

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